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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/645,185
Filing Date: August 21, 2003
Appellant(s): CHILDERS, WINTHROP

Steven Nichols
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 11 April 2008 appealing from the Office action mailed 13 November 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows:

Claim 9 was rejected under 35 U.S.C. § 103 (a) as being unpatentable over the combined teachings of Dorenbosch, Lee-2, Lee, and U.S. Pat. No. 5,124,912 to Hotaling et al.

Claims 10, 12, and 13 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over the combined teachings of Dorenbosch, Lee-2, Lee, and Official Notice.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,124,912	HOTALING et al	06-1992
US2004/0039723	LEE et al	02-2004
US 2004/0064355	DORENBOSCH et al	04-2004
7,143,177	JOHNSON et al	11-2006
US 2006/0010317	LEE	01-2006
US 2003/0208565	NISHIHARA et al	11-2003

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 5, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dorenbosch et al [US 2004/0064355] in view of Lee et al [US 2004/0039723].

As per **claim 1**, Dorenbosch et al discloses a reservation system server capable of communicating over a network with a client that fulfils projector and venue reservation requests received via the network [0012; 0013; 0016; 0017; see Fig. 1 & 2].

Dorenbosch does not disclose the reservation system server coordinates the transport

and storage of presentation data received via the network; and one or more projector systems capable of communicating with the reservation system server that download the presentation data for display according to the projector and venue reservation requests [0031]. However, Lee et al discloses periodically connecting to server to download presentation content to database memory storage of the display system that includes projector software [0030; 0034]. Lee et al further discloses that the display administrator determines the content that is provided on specific display systems and the schedule for displaying the content on specific displays [0027] wherein the systems are located remotely [0025]. Thus, the administrator controls what content is downloaded to a display in a specific location (i.e., venue request). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Dorenbosch et al to include the method disclosed by Lee et al so that the administrator does not have to be present at the location of the presentation (i.e., remotely located) to setup presentation.

As per **claim 5**, Dorenbosch does not explicitly disclose wherein the reservation system server comprises a computer including a processor, random access memory, network interface, and mass storage device. However, Dorenbosch discloses a server for executing applications [0013]. Furthermore, Lee et al discloses wherein the reservation system server comprises a computer including a processor, random access memory, network interface, and mass storage device. [Fig. 1; 0042]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to

modify the invention of Dorenbosch to include the method disclosed by Lee et al to reduce human intervention.

As per **claim 7**, Dorenbosch et al further discloses wherein the network comprises the Internet [0022].

Claims 2 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dorenbosch et al [US 2004/0064355] in view of Lee et al [US 2004/0039723] as applied to claim 1 above, and further in view of Official Notice.

As per **claim 2**, Dorenbosch et al does not disclose wherein the uploaded presentation data is stored with password protection. However, the Examiner takes Official Notice that it is old and well known at the time of the invention in the presentation industry to use a password to access a presentation. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Dorenbosch et al to include wherein the uploaded presentation data is stored with password protection so that only authorized users can view private content.

As per **claim 6**, Dorenbosch et al further discloses wherein the projector system comprises a projector communicating with a computer including a processor, random access memory, and mass storage device [0030; 0034]. Dorenbosch et al does not explicitly disclose that the projector is a digital projector. However, the Examiner takes Official Notice that it is old and well known at the time of the invention in the projector industry that a projector can be a digital projector. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the

invention of Dorenbosch et al to include wherein the projector system includes a digital projector for better picture quality.

Claims 3, 4 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dorenbosch et al [US 2004/0064355] in view of Lee et al [US 2004/0039723] as applied to claim 1 above, and further in view of Hamid et al [US 2006/0288229].

As per **claim 3**, Dorenbosch et al does not disclose wherein the uploaded presentation data is stored with encryption protection. However, Hamid et al discloses using encryption to access a file [0044]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Dorenbosch et al to include the method disclosed by Hamid et al so that only authorized users can view private content.

As per **claim 4**, Dorenbosch et al does not disclose wherein the uploaded presentation data is stored with biometric verification protection including iris scan, fingerprint recognition, or voice identification. However, Hamid discloses using biometric verification to access a file [0044]. Further, it is old and well known in the biometric art at the time of the invention that iris scan, fingerprint recognition, and voice identification are all common forms of biometric verification. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Dorenbosch et al to include the method disclosed by Hamid et al so that only authorized users can view private content.

As per **claim 31**, Dorenbosch et al discloses select a presentation venue and select a projector [0012; 0013; 0016; 0017; see Fig. 1 & 2]. Dorenbosch et al does not disclose coordinate uploading, security, and storage of presentation data; coordinate delivery of presentation data to the projector system at the time and date specified by the reservation; and coordinate the presentation or the presentation data. However, Lee et al discloses periodically connecting to server to download presentation content to database memory storage of the display system that includes projector software [0030; 0034]. Lee et al further discloses that the display administrator determines the content that is provided on specific display systems and the schedule for displaying the content on specific displays [0027] wherein the systems are located remotely [0025]. Thus, the administrator controls what content is downloaded to a display in a specific location (i.e., venue request). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Dorenbosch et al to include the method disclosed by Lee et al so that the administrator does not have to be present at the location of the presentation (i.e., remotely located) to setup presentation. Furthermore, Hamid et al discloses using encryption to access a file [0044]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Dorenbosch et al to include the method disclosed by Hamid et al so that only authorized users can view private content.

Claims 8, 11, 14, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dorenbosch et al [US 2004/0064355] in view of Lee [US 2006/0010317] and Lee et al [US 2004/0039723].

As per **claims 8 and 29**, Dorenbosch et al discloses selecting a presentation venue having one or more available projectors and in accordance with venue selection criteria for a given presentation [0014; 0018] and selecting a projector according to projector selection criteria for the presentation and the one or more projectors available at the venue [0017; 0018]. Dorenbosch et al does not disclose selecting a level of security for storing the presentation data to protect the presentation data from unauthorized access. However, Lee discloses selecting varying levels of security for access to a file [0018]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Dorenbosch et al to include the method disclosed by Lee so that only authorized users can view confidential materials. Dorenbosch et al does not further disclose uploading the presentation data to a reservation system server via the network. However, Lee et al discloses that a display system connects to a distribution server to download presentation content via a network [0034; 0036]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Dorenbosch et al to include the method disclosed by Lee et al so that the content may be viewed at a remote site.

As per **claim 11**, Dorenbosch et al does not disclose wherein the security level includes password protection. , Lee discloses selecting varying levels of security for access to a file such as a password [0018]. Therefore, it would have been obvious to

one of ordinary skill in the art at the time of the invention to modify the invention of Dorenbosch et al to include the method disclosed by Lee so that only authorized users can view confidential materials.

As per **claim 14**, Dorenbosch et al does not disclose wherein the presentation data uploading can take place at an arbitrary time. However, Lee et al discloses that a administrator can log onto a website and upload content data to a distribution server [0059]. It is well known that a user can access a website 24/7. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Dorenbosch et al to include wherein the presentation data uploading can take place at an arbitrary time to provide a user with added flexibility.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dorenbosch et al [US 2004/0064355] in view of Lee [US 2006/0010317] and Lee et al [US 2004/0039723] as applied to claim 8 above, and further in view of Hotaling et al [US 5,124,912].

As per **claim 9**, Dorenbosch et al further does not disclose further discloses wherein the venue selection criteria includes at least one criterion chosen from a group of criteria including city, location within the city, seating capacity, screen size, digital projector availability, sound system characteristics, and hotel room availability. However, Hotaling et al discloses wherein the venue selection criteria includes at least one criterion chosen from a group of criteria including city, location within the city,

seating capacity, screen size, digital projector availability, sound system characteristics, and hotel room availability [col 6, lines 30-67]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Dorenbosch et al to include the method disclosed by Hotaling et al so that a room that is sufficient to handle the meeting is reserved.

Claim 10, 12, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dorenbosch et al [US 2004/0064355] in view of Lee [US 2006/0010317] and Lee et al [US 2004/0039723] as applied to claim 8 above, and further in view of Official Notice.

As per **claim 10**, Dorenbosch does not disclose wherein the projector selection criteria include display size in pixels, projected image brightness, color fidelity, and lens system capable of zooming. However, the Examiner takes Official Notice that it is old and well known in the art at the time of the invention that projectors can be selected based on display size in pixels, projected image brightness, color fidelity, and lens system capable of zooming. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Dorenbosch et al to include wherein the projector selection criteria include display size in pixels, projected image brightness, color fidelity, and lens system capable of zooming so that the user can have a presentation that meets his/her standards.

As per **claim 12**, Dorenbosch et al does not disclose wherein the security level includes encryption protection. However, Lee discloses selecting varying levels of security for access to a file [0018]. Furthermore, the Examiner takes Official Notice that

it is old and well known in the art at the time of the invention that encryption can be used to provide file security. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Dorenbosch et al to include the method disclosed by Lee so that only authorized users can view confidential materials.

As per **claim 13**, Dorenbosch et al does not disclose wherein the security level includes protection by biometric verification including iris scan, fingerprint recognition, or voice identification. However, Lee discloses selecting varying levels of security for access to a file [0018]. Furthermore, the Examiner takes Official Notice that it is old and well known in the art at the time of the invention that biometric verification can be used to provide file security. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Dorenbosch et al to include the method disclosed by Lee so that only authorized users can view confidential materials.

Claims 15, and 18-22, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dorenbosch et al [US 2004/0064355] in view of Lee et al [US 2004/0039723] and Johnson et al [US 7,143,177].

As per **claim 15**, Dorenbosch et al discloses receiving a projector and presentation venue reservation request client [0012; 0013; 0016; 0017; see Fig. 1 & 2]. Dorenbosch et al does not disclose downloading presentation data from a projector reservation client

and commencing a presentation including presentation data. However, Lee et al discloses that the administrator logs into the client and uploads selected files to distribution server [0059]. Lee et al further discloses that the content is retrieved and the files are played [Fig. 23]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Dorenbosch et al to include the method disclosed by Lee et al so that the administrator does not have to be present at the location of the presentation (i.e., remotely located) to setup presentation. Dorenbosch et al does not further disclose ensuring availability of presentation software compatible with the presentation data. However, Johnson et al discloses registering for a presentation and if the presentation required a specific software, checking for the software and advising the client if the software must be downloaded [col 10, lines 45-56]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Dorenbosch et al to include the method disclosed by Johnson et al so that the user does not have to worry about not being prepared for the presentation.

As per **claim 18**, Dorenbosch et al does not disclose wherein the uploaded presentation data is stored on the reservation system server. However, Lee et al discloses presentation content is downloaded a distribution server and the display system connects to the distribution server and downloads content [0059; 0060]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Dorenbosch et al to include the method disclosed by

Lee et al so that the content can be easily retrieved by the display system without user intervention.

As per **claim 19**, Dorenbosch et al does not disclose wherein the uploaded presentation data is stored on a projector system. However, Lee et al discloses periodically connecting to server to download presentation content to database memory storage of the display system that includes projector software [0030; 0034]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Dorenbosch et al to include the method disclosed by Lee et al so that the administrator does not have to be present at the location of the presentation (i.e., remotely located) to setup presentation.

As per **claims 20-22**, Dorenbosch et al does not disclose wherein ensuring the availability of proper presentation software, comprises: determining if presentation software compatible with the presentation data is loaded and available for use; and updating the presentation software to a version compatible with the presentation data. However, Johnson et al discloses registering for a presentation and if the presentation required a specific software, checking for the software and advising the client if the software must be downloaded [col 10, lines 45-56]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Dorenbosch et al to include the method disclosed by Johnson et al so that the user does not have to worry about not being prepared for the presentation.

As per **claim 26**, Dorenbosch et al does not disclose wherein commencing the presentation includes reading the stored presentation data, converting the presentation

data to graphic images, and projecting the graphic images via a digital projector. However, Lee et al discloses reading the stored presentation data and converting them for display using projector software [0070-0073]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Dorenbosch et al to include the method disclosed by Lee et al to facilitate presentation viewing.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dorenbosch et al [US 2004/0064355] in view of Lee et al [US 2004/0039723] and Johnson et al [US 7,143,177] as applied to claim 15 above, and further in view of Hamid et al [US 2006/0288229].

As per **claim 16**, Dorenbosch et al does not disclose further comprising receiving a password, decryption key, or biometric verification to access presentation data. However, Hamid et al discloses comprising receiving a password, decryption key, or biometric verification to access a file [0044]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Dorenbosch et al to include the method disclosed by Hamid et al so that only authorized users can view private content.

Claims 17 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dorenbosch et al [US 2004/0064355] in view of Lee et al [US 2004/0039723] and

Johnson et al [US 7,143,177] as applied to claim 15 above, and further in view of Nishihara et al [US 2003/0208565].

As per **claim 17**, Dorenbosch et al does not disclose further comprising post-processing of presentation data. However, Nishihara et al discloses post-processing of a file after transfer [0067]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Dorenbosch et al to include the method disclosed by Nishihara et al so that unauthorized users cannot view private content.

As per **claim 27**, Dorenbosch et al does not disclose wherein post-processing of the presentation data comprises rendering the presentation data unrecoverable. However, Nishihara et al discloses post-processing of a transferred file includes deleting the file. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Dorenbosch et al to include the method disclosed by Nishihara et al so that unauthorized users cannot view private content.

Claims 23-25 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dorenbosch et al [US 2004/0064355] in view of Lee et al [US 2004/0039723], and Johnson et al [US 7,143,177], and Hamid et al [US 2006/0288229] as applied to claim 15 above, and further in view of Official Notice.

As per **claim 23**, Dorenbosch et al does not disclose wherein the password is entered via a keyboard associated with the projector system. However, Hamid et al discloses comprising receiving a password, decryption key, or biometric verification to

access a file [0044]. Furthermore, the Examiner takes Official Notice that it is old well known in the art at the time of the invention to use a keyboard to enter a password. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Dorenbosch et al to include the method disclosed by Hamid et al an using a keyboard so that only authorized users can view private content.

As per **claim 24**, Dorenbosch et al does not disclose wherein the decryption key is supplied by a portable medium including a floppy disc, compact disc, or flash memory. However, Hamid et al discloses comprising receiving a password, decryption key, or biometric verification to access a file [0044]. Furthermore, the Examiner takes Official Notice that it is old well known in the art at the time of the invention to use a portable medium including a floppy disc, compact disc, or flash memory to supply a decryption key. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Dorenbosch et al to include the method disclosed by Hamid et al an using a portable medium including a floppy disc, compact disc, or flash memory to supply a decryption key so that only authorized users can view private content.

As per **claim 25**, Dorenbosch et al does not disclose wherein biometric verification includes iris scan, fingerprint recognition, or voice identification. However, Hamid et al discloses comprising receiving a password, decryption key, or biometric verification to access a file [0044]. Furthermore, the Examiner takes Official Notice that it is old well known in the art at the time of the invention that iris scan, fingerprint recognition, and voice identification are all common forms of biometric verification.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Dorenbosch et al to include the method disclosed by Hamid et al and include wherein biometric verification includes iris scan, fingerprint recognition, or voice identification so that only authorized users can view private content.

As per **claim 28**, Dorenbosch et al does not disclose wherein the updating further comprises purchasing the software version compatible the presentation data. However, Johnson et al discloses registering for a presentation and if the presentation required a specific software, checking for the software and advising the client if the software must be downloaded [col 10, lines 45-56]. Furthermore, the Examiner takes Official Notice that it is old well known in the art at the time of the invention to purchase compatible software, if the software is not available. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Dorenbosch et al to include the method disclosed by Johnson et al to include purchasing compatible software so that the user does not have to worry about not being prepared for the presentation.

Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lee et al [US 2004/0039723] in view of Johnson et al [US 7,143,177] and Hamid et al [US 2006/0288229].

As per **claim 30**, Lee et al discloses means for receiving presentation data from a projector reservation client [0059] and means for commencing a presentation of the presentation data [0005; Fig. 23]. Lee et al does not disclose means for ensuring availability of proper presentation software. However, Johnson et al discloses registering for a presentation and if the presentation required a specific software, checking for the software and advising the client if the software must be downloaded [col 10, lines 45-56]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Dorenbosch et al to include the method disclosed by Johnson et al so that the user does not have to worry about not being prepared for the presentation. Lee et al does not disclose means for receiving a password, decryption key, or biometric verification for accessing presentation data. However, Hamid et al discloses comprising receiving a password, decryption key, or biometric verification to access a file [0044]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Lee et al to include the method disclosed by Hamid et al so that only authorized users can view private content.

Claim 32 rejected under 35 U.S.C. 103(a) as being unpatentable over Dorenbosch et al [US 2004/0064355] in view of Lee et al [US 2004/0039723] and Hamid et al [US 2006/0288229] as applied to claim 31 above, and further in view of Johnson et al [US 7,143,177].

As per **claim 32**, Dorenbosch et al does not disclose further comprising assuring the availability of the proper presentation software for the uploaded presentation data. However, Johnson et al discloses registering for a presentation and if the presentation required a specific software, checking for the software and advising the client if the software must be downloaded [col 10, lines 45-56]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Dorenbosch et al to include the method disclosed by Johnson et al so that the user does not have to worry about not being prepared for the presentation.

Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dorenbosch et al [US 2004/0064355] in view of Lee et al [US 2004/0039723], and Hamid et al [US 2006/0288229] as applied to claim 31 above, and further in view of Nishihara et al [US 2003/0208565].

As per **claim 33**, Dorenbosch et al does not disclose further comprising performing post-processing on the presentation data after the presentation. Dorenbosch et al does not disclose wherein post-processing of the presentation data comprises rendering the presentation data unrecoverable. However, Nishihara et al discloses post-processing of a transferred file includes deleting the file. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Dorenbosch et al to include the method disclosed by Nishihara et al so that unauthorized users cannot view private content.

(10) Response to Argument

Claims 1, 5, and 7

Appellant argues, "In the declaration, the inventor expressly states that he, the inventor, prior to October 1, 2002, "I conceived of my invention and diligently worked toward constructively reducing my invention to practice by filing U.S. Application No. 10/645,185 on August 21. 2003." The Examiner has not provided any basis or reasoning for doubting this declared statement of the inventor that acts as demonstrating adequate diligence occurred during the time period in question." First, the Examiner notes that, in the declaration provided on 21 August 2007, the Applicant stated, "Following my conception prior to October 1, 2002, I worked diligently with the Patent Attorney, Leland Wiesner, Esq. to prepare the patent application filed on August 21, 2003 thereby constructively reducing the invention to practice. During this time period, the patent attorney prepared one or more drafts of the application for my comments. With my comments, the patent attorney revised one or more portions of the application, claims and/or figures to accommodate my suggestions." (Applicant's declaration filed with Arguments/Remarks dated 21 August 2007). An applicant must account for the entire period during which diligence is required. *Gould v. Schawlow*, 363 F.2d 908, 919, 150 USPQ 634, 643 (CCPA 1966) (Merely stating that there were no weeks or months that the invention was not worked on is not enough.); *In re Harry*, 333 F.2d 920, 923, 142 USPQ 164, 166 (CCPA 1964) (**statement that the subject matter "was diligently reduced to practice" is not a showing but a mere pleading**), see MPEP 2138.06. The diligence of attorney in preparing and filing patent application

inures to the benefit of the inventor. Conception was established at least as early as the date a draft of a patent application was finished by a patent attorney on behalf of the inventor. Conception is less a matter of signature than it is one of disclosure. Attorney does not prepare a patent application on behalf of particular named persons, but on behalf of the true inventive entity. Six days to execute and file application is acceptable. *Haskell v. Coleburne*, 671 F.2d 1362, 213 USPQ 192, 195 (CCPA 1982). See also *Bey v. Kollonitsch*, 866 F.2d 1024, 231 USPQ 967 (Fed. Cir. 1986) (Reasonable diligence is all that is required of the attorney. Reasonable diligence is established if attorney worked reasonably hard on the application during the continuous critical period. If the attorney has a reasonable backlog of unrelated cases which he takes up in chronological order and carries out expeditiously, that is sufficient. Work on a related case(s) that contributed substantially to the ultimate preparation of an application can be credited as diligence.). In this case, the Attorney has not proven that there was any reasonable explanation for taking a period from prior to October 1, 2002 until August 21, 2003 to prepare a specification that is 11 pages long. Exhibit A shows a HP Invention Disclosure document that is 6 pages long and contains most of what has been provided in the specification filed with the Patent and Trademark Office on 21 August 2003. It seems highly unlikely that a 10-month period was required for preparing at least one or more drafts and filing of a patent application. The Examiner's position is further supported by the fact in the Arguments/Remarks filed on 21 August 2007 the attorney tried to disqualify the references to both Dorenbosch et al and Lee utilizing the Declaration filed at the same time. However, when the Appellant noticed that it was

difficult to prove that it was reasonable to take a 10-month period to prepare an 11 page specification, the Appellant changed his position (from the Remarks on 8/21/07) and decided only to challenge the Examiner's position with respect to Lee et al (as opposed to Dorenbosch et al and Lee et al). Thus, the Appellant has not proved that due diligence was taken during the time period of October 1, 2002 until August 21, 2003 to reduce the invention to practice.

Appellant further argues, "In the case of Lee, Appellant must show diligence from just before April 3, 2003 to an actual reduction to practice or August 21, 2003. If the discourse document produced by Appellant on or before September 23, 2002 is recognized as an actual reduction practice, Lee is clearly not valid prior art against the present application under Rule 131 and Appellant previously-filed declaration." The Examiner asserts that it has been well established that, "In an interference proceeding, a party seeking to establish an actual reduction to practice must satisfy a two-prong test: (1) the party constructed an embodiment or performed a process that met every element of the interference count, and (2) the embodiment or process operated for its intended purpose." *Eaton v. Evans*, 204 F.3d 1094, 1097, 53 USPQ2d 1696, 1698 (Fed. Cir. 2000)." See MPEP 2183.05. Thus, Exhibit A is insufficient to establish a reduction to practice because it does not supply any evidence that the apparatus described in the claims ever existed prior to October 1, 2002 and worked for its intended purpose. Appellant also argues, "Alternatively, Appellant would need to show diligence during the four-month period from April 3, 2003 to August 21, 2003....a four month period is a perfectly reasonable period during which an Appellant may work with an attorney to

draft and file a patent application, such as occurred in this case on August 21, 2003." Examiner asserts that as stated above, in the declaration provided on 21 August 2007, the Applicant stated, "Following my conception prior to October 1, 2002, I worked diligently with the Patent Attorney, Leland Wiesner, Esq. to prepare the patent application filed on August 21, 2003 thereby constructively reducing the invention to practice. During this time period, the patent attorney prepared one or more drafts of the application for my comments. With my comments, the patent attorney revised one or more portions of the application, claims and/or figures to accommodate my suggestions." (Applicant's declaration filed with Arguments/Remarks dated 21 August 2007). First, the Examiner notes that it is not clear from this statement by the Inventor that period in which the draft applications were generated were only during the previously mentioned four month period. As such, the Examiner denied the Declaration as being insufficient to prove diligence. It appeared highly unreasonable for the Applicant to take a period of 10 months to prepare and file a patent application of 11 pages. It further appears that the Appellant decided to change his position on the period in which the Inventor diligently worked with the attorney to prepare the patent application. In particular, in the Arguments/Remarks filed on 21 August 2007 the attorney tried to disqualify the references to both Dorenbosch et al and Lee utilizing the Declaration. However, when the Appellant noticed that it was difficult to prove that it was reasonable to take a 10-month period to prepare an 11 page specification, the Appellant changed his position (from the Remarks on 8/21/07) and decided only to assert in the Appeal Brief (this argument was not asserted in any previous

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remarks/arguments) that the statement was provided to show diligence was taken during the four month period. Thus, the Appellant has not proved, based on the facts provided in previous communications, that due diligence was taken to reduce the invention to practice.

Claims 2-4, 6, and 8-33

Claims 2-4, 6, and 8-33 depend on independent claims 1, 5, and/or 7, and as such contain all the limitations of claims 1, 5, and/or 7. Claims 1, 5, and/or 7 are not patentable for the reasons above. Thus, claims 12-4, 6,m and 8-33 are rejected for the same reasons as claims 1, 5, and /or 7.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Shannon S Saliard/

Examiner, Art Unit 3628

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